UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,237	09/21/2001	Andreas Herkersdorf	CH9-2000-0019US1(590.082)	5867

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EXAMINER
VU, THONG H

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>07 March 2006</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-16</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-16</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1.   Claims 1-16 are pending.

Response to Arguments

2.   Applicant's arguments filed 3/07/06 with respect to claims 1-16 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3.   Claim 16 using a language that may raise a question as to the limiting effect of

the language in a claim (i.e.: whereby). Correction is required.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:
(A)   statements of intended use or field of use,
(B)   "adapted to" or "adapted for" clauses,
(C)   "wherein" clauses, or
(D)   "whereby" clauses.
This list of examples is not intended to be exhaustive. >See also MPEP § 2111.04. Office personnel must rely on the applicant's disclosure to properly determine the meaning of the claims. Markman v. Westview Instruments, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (en banc), aff 'd, U.S., 116 S. Ct. 1384 (1996). Claim terms are presumed to have the ordinary and customary meanings attributed tothem by those of ordinary skill in the art. Sunrace Roots Enter. Co. v. SRAM Corp., 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1298, 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)("In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art.") However, an applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning. See In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) >and Vitronics Corp. v. Conceptronic Inc., 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996)<. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir.

1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings."). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." Multiform Desiccants Inc. v. Medzam Ltd., 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

Double Patenting

4.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are rejected on the ground of nonstatutory double patenting over claims 1-12 of U. S. Patent No. 4,937,760 ('760) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

('760) 1. A computer-implemented method for sharing common values implicitly among generative objects, the objects respectively being accessible only across counterpart logically partitioned and isolated <u>demand/response</u> interfaces (interactive, exchange) , at least one of the partitions including a cyclic, rule-based, object-sensitive production system otherwise termed a knowledge processing environment (KPE), comprising the steps of:

(a) creating a process in each partition cooperative with counterpart concurrent processes in other partitions across the counterpart synchronous demand/response interface;

(b) processes in each partition selectively creating, modifying, or deleting common values, and forming a list of changes;

(c) processes in other than the KPE partition communicating any change list to the KPE partition independent from and concurrently with any procedural request to the KPE partition;

(d) causing the KPE partition to update its common values according to the change list; and

(e) altering any change list originating at the KPE partition into <u>a format readily usable</u> (menu, predetermined response options) by a process in a non-KPE partition and communicating said formatted change list to said non-KPE partition.

2. wherein said production system in the KPE partition further includes a frame manager for creating and manipulating frames among objects;

wherein the common values are included in only those frames which constitute a common <u>subset of all of the frames</u> (subset of client machines); and wherein the common values in non-KPE partitions are formatted as records.

(Application) 1. A method for handling interactive information exchange through networks having a plurality of client machines, the method comprising the steps of:

composing a request message offering <u>predetermined response options</u>, whereby corresponding response messages are returned through said networks in one (or more) packet(s);

setting up packet forwarding rules in said networks specifying a particular treatment for said returned packets dependent on said predetermined response options;

sending said request message to said <u>subset of client machines</u>

Furthermore, there is no apparent reason why applicant was prevented from

presenting claims corresponding to those of the instant application during prosecution of

the application which matured into a patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12,14-16 are rejected under 35 U.S.C. 102(e) as anticipated by

Loveland 6,782,413 B1].

5.   As per claim 16, Loveland discloses A system for handling information exchange

through computer networks having a plurality of client machines for interactive

broadcasting [Loveland, Internet, Fig 2], the system comprising

a host computer connected to one of said networks for composing a request

message offering predetermined response options [Loveland, a configured response

option, col 17 lines 55-col 18 line 15], **whereby** corresponding response messages are

returned over said computer network in one or more packets and sending said request

message to at least a subset of said plurality of client machines [Loveland, Intranet, col

15 lines 52-62], and

an interface for setting up packet forwarding rules said computer network

specifying a particular treatment for said returned packets dependent on said

predetermined response options [Loveland, a set of response rules col 16 line 63-17

line 11; routing/rules engine, col 7 lines 16-30].

6.   Claims 1, 15 contain the similar limitations set forth of claim 16. Therefore, claim

1,15 are rejected for the similar rationale set forth in claim 16.

7.   As per claim 2, Loveland discloses an initial step of receiving a subscription

message from a subset of said client machines [Loveland, Intranet, col 15 lines 52-62].

8.   As per claim 3, Loveland discloses said request message is composed in that

said corresponding response message only consists of one packet as a design choice

of the response option.

9.   As per claim 4, Loveland discloses said request message is composed in a way

that said chosen predetermined response options is encoded in a data portion of said

respective response packet [Loveland, encoded message, col 9 line 12].

10.   As per claim 5, Loveland discloses said request message is composed in a

hypertext document format (i.e.: web forms) and a program that can be executed on the

client machines and composes said response messages upon an interaction of a user

of a client machine [Loveland, Internet, col 1 line 30; web forms, col 9 lines 60].

11.   As per claim 6, Loveland discloses setting up forwarding rules includes the step

of configuring one or more routers (i.e.: proxy) that forward said response packets

[Loveland, proxy 190, Fig 4].

12.   As per claim 7, Loveland discloses configuring said routers includes the step of

instructing said routers to discard response messages containing predetermined

response options as a filter [Loveland, proxy 190, Fig 4].

13.   As per claim 8, Loveland discloses configuring said routers includes the step of

instructing said routers to forward response messages containing a certain response

option to a specified host connected to one of said networks [Loveland, proxy 190, Fig

4].

14.   As per claim 9, Loveland discloses configuring said routers combine more than

one response messages arriving in a given time frame and to forward the combined

messages as one message [Loveland, proxy 190, Fig 4; combines access, col 11 line

26; merges the two conference bridges, col 21 liens 38-55].

15.   As per claim 10, Loveland discloses configuring said routers includes the step of

instructing at least one of said routers to store the selected option of said response

options in conjunction with the identity of the sender [Loveland, select an option, col 18

lines 30-46].

16.   As per claim 11, Loveland discloses configuring said routers includes the step of

instructing at least one of said routers to determine the amount of received response

messages for each response option [Loveland, configuration response options, col 17

line 55-col 18 line 15].

17.   As per claim 12, Loveland discloses the steps of receiving response messages

and sending a second request message only to client machines from which a response

message containing a certain response option was received [Loveland, second

conference phone number, col 3 lines 7-15].

18.   As per claim 14, Loveland discloses a computer program product stored on a

computer usable medium [Loveland, CD-ROM col 5 line 46].

Claim Rejections - 35 USC § 103

        The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

        Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Loveland 6,782,413 B1] in view of Ward [7,020,618 B1].

19.   As per claim 13, Loveland discloses receiving response messages and storing

the options [Loveland, sending menus to presenting options to caller, col 18 lines 30-

46]. However Loveland does not explicitly detail the options chosen grouped by said

sending client machines.

In the same endeavor, Ward discloses a method and system for customer

service process management wherein the service has ability to group structured

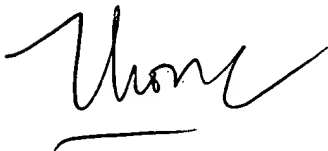sentences or options [Ward, col 7 lines 33-45]

Therefore it would be obvious to an ordinary skill in the art at the time the

invention was made to incorporate the group sentences or group options as taught by

Ward into the Loveland's apparatus in order to utilize the management or configuration

process. Doing so would provide the variety and flexibility of uses for system.

        Any inquiry concerning this communication or earlier communications from the
examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-
272-3904. The examiner can normally be reached on Monday-Thursday from 6:00AM-
3:30PM.
        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the
organization where this application or proceeding is assigned is 571-273-8300
        Information regarding the status of an application may be obtained from the
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Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Primary Examiner
Art Unit 2142